



PATENT  
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Appeal  
Brief  
(3)  
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1-20-02

In re Application of:

Martin Kelly Jones

Serial No.: 09/163,588

Filed: September 30, 1998

For SYSTEM AND METHOD FOR  
ACTIVATION OF ADVANCE  
NOTIFICATION SYSTEM FOR  
MONITORING AND REPORTING  
STATUS OF VEHICLE TRAVEL

Examiner: Louis-Jacques, J.

Art Unit: 3661

Docket No: 050711-1028

APPEAL BRIEF UNDER 37 C.F.R. §1.192

Assistant Commissioner for Patents  
Box: AF (Appeal Brief)  
Washington, DC 20231

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Sir:

This Appeal Brief under 37 C.F.R. §1.192 is submitted in triplicate in support of the Notice of Appeal filed October 22, 2001, responding to the final Office Action of July 26, 2001.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those which may otherwise be provided for in documents accompanying this paper.

However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to Deposit

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### **REAL PARTY IN INTEREST**

The real parties in interest are Global Research Systems, Inc. and Buscall Properties, L.L.C.

### **RELATED APPEALS AND INTERFERENCES**

There are no known related appeals or interferences that will affect or be affected by a decision in this appeal.

### **STATUS OF CLAIMS**

Claims 1-11, 13, 14, 16-23, 27-32, 35-39, and 41-55 stand finally rejected. No claims have been allowed. The final rejection of claims 1-11, 13, 14, 16-23, 27-32, 35-39, and 41-55 is appealed.

### **STATUS OF AMENDMENTS**

This application was originally filed on September 30, 1998, with claims 1-40. A non-final Office Action was mailed from the U.S. Patent and Trademark Office ("PTO") on March 29, 2000, rejecting claims 1-40. A First Response was filed with the PTO on July 31, 2000, amending claims 1, 3-5, 10, 11, 13, 18-23, 27, 31-32, 35, and 39; canceling claims 12, 15, 24-26, 33, 34, and 40; and adding claims 41-55. A final Office Action was then mailed from the PTO on September 7, 2000, finally rejecting claims 1-11, 13, 14, 16-23, 27-32, 35-39, and 41-55. A Second Response was filed with a Request for Continuing Examination with the PTO on January 8, 2001, attempting to traverse rejection of aforementioned claims. A non-Final Office Action was mailed from the PTO on February 12, 2001, rejecting claims 1-11, 13, 14, 16-23, 27-32, 35-39, and 41-55. Then, a Third Response was filed with the PTO on June 12, 2001, attempting to traverse the rejection of claims 1-

11, 13, 14, 16-23, 27-32, 35-39, and 41-55. A Final Office Action was mailed from the PTO on July 26, 2001, rejecting claims 1-11, 13, 14, 16-23, 27-32, 35-39, and 41-55. The final rejection of claims 1-11, 13, 14, 16-23, 27-32, 35-39, and 41-55 is appealed.

### **SUMMARY OF THE INVENTION**

In general, the present invention provides an automated system and method for monitoring travel of a vehicle that can be efficiently activated by a user at a remote location. In this regard, a vehicle control unit located on the vehicle determines the vehicle's location as the vehicle travels and monitors the travel of the vehicle. In one embodiment, a user at a remote location transmits a vehicle indicator and a location to a communications interface. The vehicle indicator identifies a particular vehicle, and the location indicator identifies a location along the vehicle's route of travel. The communications interface transmits the vehicle indicator and the location indicator to a data manager, and the data manager retrieves location data based on the location indicator. The data manager then correlates and compares the location data with travel data associated with the vehicle. The travel data indicates the current location of the vehicle, and the data manager transmits a message to the user, when the data manager determines that the vehicle is a predetermined proximity from the location identified by the location indicator.

## ISSUES

The following issues need to be decided as part of this appeal:

1. Whether U.S. Patent 5,648,770 (*Ross*) should be removed as a prior art reference to claims 1-11, 13-14, 16-23, 27-32, 35-39, and 41-55 pursuant to 37 C.F.R. §1.131.
2. Whether U.S. Patent 5,648,770 (*Ross*) should be removed as a prior art reference to claims 1-11, 13-14, 16-23, 27-32, 35-39, and 41-55 pursuant to 37 C.F.R. §1.132.
3. Whether claims 1-11, 13-14, 16-23, 27-32, 35-39, and 41-55 are patentable over U.S. Patent 5,648,770 (*Ross*) in view of U.S. Patent 5,168,451 (*Bolger*).

## GROUPING OF CLAIMS

With respect to claims 1-11, 13-14, 16-23, 27-32, 35-39, and 41-55, the claims of the group do **not** stand or fall together; but rather:

1. claims 1-11, 13-14, 16-23, 27-32, 35-39, and 41-55 stand or fall as a group (group 1) with respect to the rejections over the 5,648,770 patent to *Ross* in view of the 5,168,451 patent to *Bolger* for at least the reason that the *Ross* patent is not a valid prior art reference under 37 C.F.R. §1.131; and
2. claims 1-11, 13-14, 16-23, 27-32, 35-39, and 41-55 stand or fall as a group (group 2) with respect to the rejections over the 5,648,770 patent to *Ross* in view of the 5,168,451 patent to *Bolger* for at least the reason that the *Ross* patent is not a valid prior art reference under 37 C.F.R. §1.132; and
3. claims 1-11, 13-14, 16-23, 27-32, 35-39, and 41-55 stand or fall as a group (group 3) with respect to the rejections over the 5,648,770 patent to *Ross* in view of the 5,168,451

patent to *Bolger* for at least the reason that the proposed combination of *Ross* in view of *Bolger* fails to disclose and/or teach the feature of reporting vehicle arrivals in response to activation requests from users.

4. claims 4-5, 19-20, and 39 stand or fall as a group (group 4) with respect to the rejections over the 5,648,770 patent to *Ross* in view of the 5,158,451 patent to *Bolger* for at least the reason that the proposed combination *Ross* in view of *Bolger* fails to disclose and/or teach the feature of notifying a recipient when a vehicle is within a proximity that is not based on an interval of time.

5. claims 10, 48, and 52 stand or fall as a group (group 5) with respect to the rejections over the 5,648,770 patent to *Ross* in view of the 5,158,451 patent to *Bolger* for at least the reason that the proposed combination *Ross* in view of *Bolger* fails to disclose and/or teach the feature of a data manager that assumes a vehicle travels according to a predetermined rate.

6. claims 27, 35, 41, 46, 50, and 55 stand or fall as a group (group 6) with respect to the rejections over the 5,648,770 patent to *Ross* in view of the 5,158,451 patent to *Bolger* for at least the reason that the proposed combination *Ross* in view of *Bolger* fails to disclose and/or teach the feature of a controller that receives contact information from a user.

## **THE ARGUMENT**

### **1. Group 1**

“(T)he fact that an application has named a different inventive entity than a patent does not necessarily make that patent prior art.” *Applied Materials Inc. v. Gemini Research Corp.*, 15 U.S.P.Q.2d 1816, 1818 (Fed. Cir. 1988). Under 35 U.S.C. § 103(a), an applicant may overcome a prior art reference that is prior art under 35 U.S.C. § 102(a) or 102(e) by establishing “conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application.” 37 C.F.R. § 1.131.

#### **a. Claims 1-11, 13-14, 16-23, 27-32, 35-39, and 41-55**

Claims 1-11, 13, 14, 16-23, 27-32, 35-39, and 41-55 presently stand finally rejected under 35 U.S.C. §103 as purportedly being obvious to U.S. Patent 5,648,770 to *Ross* in view of U.S. Patent 5,158,451 to *Bolger*. Applicant asserts that the subject matter disclosed by *Ross* and used by the Patent Office to reject the pending claims of the instant application is Applicant’s own prior invention, and the ‘770 patent, therefore, should not be used to reject the aforementioned claims.

Exhibits A-I submitted with the First Response filed July 31, 2000, show that the subject matter disclosed by *Ross* and used by the Patent Office to reject pending claims 1-11, 13, 14, 16-23, 27-32, 35-39, and 41-55 is the product of Applicant’s own work. In particular, Applicant asserts in Exhibit A that Applicant invented the subject matter relied on to reject the pending claims of the present application and that Applicant disclosed the subject matter to Mr. John Ross in efforts of obtaining financing for Applicant’s invention. It is Applicant’s contention that Mr. Ross had no conception of an advance notification system prior to the Applicant’s disclosure to Mr. Ross. Once

Applicant disclosed the advance notification system to Mr. Ross, Mr. Ross did suggest the use of a card reader system to implement on the vehicles of the advance notification system, *see* paragraph 5 of Exhibit A, but Mr. Ross had no further technical input. After Mr. Ross failed to obtain financing, the Applicant and Mr. Ross parted company, and Mr. Ross later filed patent applications including the subject matter invented by the Applicant and disclosed to Mr. Ross.

Exhibits B - H show that Applicant's assertions in Exhibit A are truthful and accurate. In this regard, Exhibit B shows that a relationship between the Applicant and Mr. Ross existed prior to the filing dates of the patents granted to Mr. Ross. Furthermore, Exhibit C shows that this relationship was terminated, as claimed by the Applicant in paragraph 4 of Exhibit A, once Mr. Ross failed to raise sufficient funds. Exhibit D shows that Mr. Ross at least conceded that the Applicant is an inventor of the advance notification system by signing a non-disclosure agreement that listed Applicant as an "inventor." *See also* paragraph 6 of Exhibit A. Note that Mr. Ross is **not** listed as an inventor on the non-disclosure agreement. Exhibits E - H submitted herewith show that third parties met with Applicant and Mr. Ross and discussed the advance notification system. Each of these third parties believed that Applicant, and not Mr. Ross, was the inventor of the product being discussed.

In particular, Mr. Mark Stubbins stated that he and the Applicant "met with Mr. Ross for the sole purpose of having him help us raise money . . . Mr. Ross's only involvement was his 'finding capital' for starting a company to exploit the technology. He had no substantive input on the ideas or concepts associated with the advance notification system. The advance notification system was conceived of and its design was well defined in both system implementations, *long before Mr. Ross was involved.*" *See* paragraph 12 of Exhibit E submitted herewith (Emphasis added). Furthermore, Mr. Stubbins reviewed a claim of the U.S. Patent 5,648,770 to Mr. Ross and

stated that the apparatus described by these claims was invented by Applicant and disclosed to Mr. Ross "before Ross thought about or knew anything about this 'apparatus.'" See paragraph 17 of the foregoing Exhibit.

Ms. Gena Payne also reviewed the same claim of the '770 patent and asserted that the subject matter of the claim was disclosed to her by Applicant and that "Ross made no claim to have invented [the apparatus], in whole or in part." See paragraph 5 of Exhibit F. In fact, Ms. Payne stated that "it is beyond amazing that John Ross can actually claim that he is the inventor of any technology surrounding the advance notification field." See paragraph 5 of the foregoing Exhibit. Furthermore, Ms. Payne (as well as Mr. Anthony Hunt) also stated that Mr. Ross *admitted* to them that the advance notification system was Applicant's idea and that Mr. Ross was helping to raise money. See paragraphs 3 and 4 of Exhibit F submitted herewith and paragraph 12 of Exhibit G submitted herewith.

Furthermore, Mr. Rusty Gordon, once a vice president at GTE, also met with Applicant and Mr. Ross regarding the advance notification system. Mr. Gordon stated that he understood Applicant to be the inventor and Mr. Ross to be a financial advisor at the meeting. See paragraph 8 of Exhibit H. Mr. Gordon also reviewed the same claim reviewed by Mr. Stubbins and Ms. Payne and stated that he discussed all of the elements of the claims "before Kelly (Applicant) met John Ross." See paragraph 10 of the foregoing Exhibit.

Consequently, Applicant respectfully asserts that Exhibits A - I submitted herewith sufficiently prove that Applicant, not Ross, invented the subject matter which was disclosed by the Ross patent and relied upon to reject the pending claims of the present application and that Mr. Ross derived this subject matter from Applicant. Accordingly, for the reasons set forth hereinbefore, the Ross patent is not a proper prior art reference.



**b. Response to Arguments by PTO**

In asserting that the '770 patent is not a valid prior art reference, Applicant relies in part upon M.P.E.P. §2136.05 which states that "(w)hen a prior U.S. patent is not a statutory bar, a 35 U.S.C. 102(e) rejection can be overcome by antedating the filing date of the U.S. patent under 37 C.F.R. §1.131." There is no requirement in M.P.E.P. §2136.05 for the applicant to be named as an inventor in the prior U.S. patent. Further, Applicant additionally relies upon *In re DeBaun*, which states that "an applicant's own work, even though publicly disclosed prior to his application, may not be used against him as a reference, absent the existence of a time bar." 214 U.S.P.Q. at 935. However, in the final Office Action mailed on July 26, 2001, it is asserted by the Patent Office that the law set forth in *In re DeBaun* "only applies to the same applicant for the patent and application." Applicant respectfully traverses this interpretation of *In re DeBaun* by the Patent Office.

The Court of Customs and Patent Appeals has stated in the case of *In re Land and Rogers* that:

there are two conditions expressed in section 102(e): (1) the application for the reference patent must have been by one who is legally "another" and (2) the filing date must be "before the invention \* \* \* by the applicant \* \* \*." When the 102(e) reference patentee got knowledge of the applicant's invention from him, as by being associated with him, \* \* \* and *thereafter* describes it, he necessarily files the application *after* the applicant's invention date and the patent as a "reference" does not evidence that the invention, when made, was already known to others. (Footnote omitted.) Evidence of such a state of facts, whatever its form, must be considered. 151 U.S.P.Q. 621, 633 (1966); see, also, *Mathews* at 279.

Noting that there is no mention of a requirement in *Land* for an applicant to be named as an inventor in a prior patent to overcome the prior patent as a reference, Applicant submits that the aforementioned interpretation of *In re DeBaun* by the Patent Office incorrectly focuses on the "by another" requirement of 35 U.S.C. §102(e) instead of the "before the invention" requirement. In

focusing on the “before the invention” requirement, the “proper subject of inquiry” is “*who* invented the subject matter disclosed by (the reference) which was relied on to support the rejection.” *Id.* at 633 n. 11; *see also, DeBaun* at 935. In other words, the proper inquiry is not who first disclosed the subject matter but rather who invented the subject matter. Consequently, to overcome a prior art reference under 35 U.S.C. §102(e), all that needs to be shown (in the absence of a time bar) is that the subject matter relied on by the Patent Office to reject the applicant’s patent application was derived from the applicant, and there is no requirement that an applicant be a named inventor of the prior art reference.

It is further asserted in the final Office Action that Applicant must show that he jointly invented the relevant subject matter disclosed in the ‘770 patent to have the ‘770 patent removed as a prior art reference pursuant there has to be an “indication that the portions of the references relied on disclosed anything they did jointly.” For the following reasons, Applicant fails to see how the foregoing statements in the Office Action show that the rejections in the outstanding Office Action are proper.

First, Applicant agrees that the “issue turns on what the evidence of record shows as to who invented the subject matter.” In this regard, Applicant asserts that the evidence of record shows (1) that Applicant invented the subject matter disclosed by the *Ross* patent and used to reject the pending claims and (2) that *Ross* derived this subject matter from Applicant. Thus, as previously set forth hereinabove, *Ross* is not a valid prior art reference.

Second, Applicant admits that the rejection in *Land* was affirmed because there “was no indication that the portions of the references relied on disclosed anything they did jointly.” However, in *Land*, a joint application filed by Rogers and Land was being rejected by one or more patents naming Land as the only inventor and one or more patents naming Rogers as the only

inventor. Further, for *DeBaun* and M.P.E.P. §2136.05 to be applicable, the applicant of a later filed application must show that he invented the subject matter being used to reject his application and that the named inventor of the asserted prior art reference derived the subject matter from the applicant. Therefore, applying the foregoing rule to the situation in *Land*, Rogers and Land had to show that the subject matter being used to reject their later filed joint application was invented by them jointly. If this was true, then the relevant subject matter disclosed in the patents to Rogers individually and in the patents to Land individually is considered to have been derived from the applicant (*i.e.*, both Rogers and Land) of the later filed joint application. As a result, the individual patents to Land and to Rogers could be removed as prior art references under *DeBaun*, and M.P.E.P. §2136.05. However, since the Court found that the foregoing was not true (*i.e.*, since the Court found that Land and Rogers did not jointly invent the relevant subject matter), the Court held that the relevant subject matter was not derived from the applicant (*i.e.*, both Rogers and Land) but instead was derived from Rogers individually and from Lands individually. Therefore, the Court properly held that the rule of law set forth in *DeBaun*, and M.P.E.P. §2136.05 should not be applied.

However, in the instant case, the Applicant is not a joint inventor, unlike the applicant in the *Lands* case. Thus, it is not necessary to show that the Applicant jointly invented the relevant subject matter disclosed in *Ross* in order to have *Ross* removed as a prior art reference pursuant to *DeBaun*, and M.P.E.P. §2136.05. Indeed, applying the rule of law set forth by *Land* to the facts of the instant case, Applicant must show that he *individually* invented the subject matter being used to reject the pending claims and that *Ross* derived this subject matter from the Applicant. If this is true, then *Ross*, according to the law set forth in *Land* and M.P.E.P. §2136.05, must be removed as a prior art reference in the absence of a time bar. Hence, even though the Court decided not to

remove the prior patents as prior art references in *Land*, there is nothing in the holding of the *Land* case to suggest that *DeBaun* and M.P.E.P. §2136.05 should not be applied in the instant situation.

Applicant respectfully asserts that there is nothing in the case law or the M.P.E.P. that requires an applicant to show an admission from the inventor or owner of a patent in order to overcome the patent pursuant to *DeBaun*, and M.P.E.P. §2136.05. Thus, Applicant asserts that the declarations and other evidence submitted by him are sufficient for showing that the subject matter disclosed by *Ross* and used to reject the pending claims of the instant application is Applicant's own prior invention. Therefore, the declarations and other evidence submitted by the Applicant are sufficient for overcoming *Ross* pursuant to *DeBaun* and M.P.E.P. §2136.05.

For the foregoing reasons, Applicant asserts that *Ross* is not a valid prior art reference to the instant application as alleged in the Office Action. Therefore, the rejection to pending claims 1-11, 13, 14, 16-23, 27-32, 35-39, and 41-55 is improper and should be withdrawn.

## 2. Group 2

"(T)he fact that an application has named a different inventive entity than a patent does not necessarily make that patent prior art." *Applied Materials Inc. v. Gemini Research Corp.*, 15 U.S.P.Q.2d 1816, 1818 (Fed. Cir. 1988). "(A)n applicant's own work, even though publicly disclosed prior to his application, may not be used against him as a reference, absent the existence of a time bar to his application." *In re DeBaun*, 214 U.S.P.Q. 933, 935 (C.C.P.A. 1982). Therefore, an applicant may overcome a rejection based on a patent "by showing that the patent disclosure is a description of applicant's own previous work. Such a showing can be made by proving that the patentee was associated with applicant (e.g. worked for the same company) and

learned of applicant's invention from applicant." M.P.E.P. §2136.05; *see also In re Mathews*, 161 U.S.P.Q. 276 (C.C.P.A. 1969).

Similar issues dealing with whether subject matter disclosed within a prior patent to John Ross could be asserted against Applicant in a later filed application were addressed in U.S. Patent Application No. 09/233,795. In that case, the Patent Office withdrew the prior patent as a prior art reference, pursuant to *DeBaun, Mathews*, and M.P.E.P. §2136.05, on the grounds that John Ross derived the relevant subject matter from the Applicant. The Board is invited to refer to the foregoing patent application as a prelude to the following arguments.

**a. Claims 1-11, 13-14, 16-23, 27-32, 35-39, and 41-55**

Claims 1-11, 13, 14, 16-23, 27-32, 35-39, and 41-55 presently stand finally rejected under 35 U.S.C. §103 as purportedly being obvious to U.S. Patent 5,648,770 to *Ross* in view of U.S. Patent 5,158,451 to *Bolger*. Applicant asserts that the subject matter disclosed by *Ross* and used by the Patent Office to reject the pending claims of the instant application is the product of Applicant's own previous work, and the '770 patent, therefore, should not be used to reject the aforementioned claims.

Exhibits A-I submitted with the First Response filed July 31, 2000, show that the subject matter disclosed by *Ross* and used by the Patent Office to reject pending claims 1-11, 13, 14, 16-23, 27-32, 35-39, and 41-55 is the product of Applicant's own work. In particular, Applicant asserts in Exhibit A that Applicant invented the subject matter relied on to reject the pending claims of the present application and that Applicant disclosed the subject matter to Mr. John Ross in efforts of obtaining financing for Applicant's invention. It is Applicant's contention that Mr. Ross had no conception of an advance notification system prior to the Applicant's disclosure to Mr. Ross. Once

Applicant disclosed the advance notification system to Mr. Ross, Mr. Ross did suggest the use of a card reader system to implement on the vehicles of the advance notification system, *see* paragraph 5 of Exhibit A, but Mr. Ross had no further technical input. After Mr. Ross failed to obtain financing, the Applicant and Mr. Ross parted company, and Mr. Ross later filed patent applications including the subject matter invented by the Applicant and disclosed to Mr. Ross.

Exhibits B - H show that Applicant's assertions in Exhibit A are truthful and accurate. In this regard, Exhibit B shows that a relationship between the Applicant and Mr. Ross existed prior to the filing dates of the patents granted to Mr. Ross. Furthermore, Exhibit C shows that this relationship was terminated, as claimed by the Applicant in paragraph 4 of Exhibit A, once Mr. Ross failed to raise sufficient funds. Exhibit D shows that Mr. Ross at least conceded that the Applicant is an inventor of the advance notification system by signing a non-disclosure agreement that listed Applicant as an "inventor." *See also* paragraph 6 of Exhibit A. Note that Mr. Ross is **not** listed as an inventor on the non-disclosure agreement. Exhibits E - H submitted herewith show that third parties met with Applicant and Mr. Ross and discussed the advance notification system. Each of these third parties believed that Applicant, and not Mr. Ross, was the inventor of the product being discussed.

In particular, Mr. Mark Stubbins stated that he and the Applicant "met with Mr. Ross for the sole purpose of having him help us raise money . . . Mr. Ross's only involvement was his 'finding capital' for starting a company to exploit the technology. He had no substantive input on the ideas or concepts associated with the advance notification system. The advance notification system was conceived of and its design was well defined in both system implementations, *long before Mr. Ross was involved.*" *See* paragraph 12 of Exhibit E submitted herewith (Emphasis added). Furthermore, Mr. Stubbins reviewed a claim of the U.S. Patent 5,648,770 to Mr. Ross and

stated that the apparatus described by these claims was invented by Applicant and disclosed to Mr. Ross “before Ross thought about or knew anything about this ‘apparatus.’” See paragraph 17 of the foregoing Exhibit.

Ms. Gena Payne also reviewed the same claim of the ‘770 patent and asserted that the subject matter of the claim was disclosed to her by Applicant and that “Ross made no claim to have invented [the apparatus], in whole or in part.” See paragraph 5 of Exhibit F. In fact, Ms. Payne stated that “it is beyond amazing that John Ross can actually claim that he is the inventor of any technology surrounding the advance notification field.” See paragraph 5 of the foregoing Exhibit. Furthermore, Ms. Payne (as well as Mr. Anthony Hunt) also stated that Mr. Ross *admitted* to them that the advance notification system was Applicant’s idea and that Mr. Ross was helping to raise money. See paragraphs 3 and 4 of Exhibit F submitted herewith and paragraph 12 of Exhibit G submitted herewith.

Furthermore, Mr. Rusty Gordon, once a vice president at GTE, also met with Applicant and Mr. Ross regarding the advance notification system. Mr. Gordon stated that he understood Applicant to be the inventor and Mr. Ross to be a financial advisor at the meeting. See paragraph 8 of Exhibit H. Mr. Gordon also reviewed the same claim reviewed by Mr. Stubbins and Ms. Payne and stated that he discussed all of the elements of the claims “before Kelly (Applicant) met John Ross.” See paragraph 10 of the foregoing Exhibit.

Consequently, Applicant respectfully asserts that Exhibits A - I submitted herewith sufficiently prove that Applicant, not Ross, invented the subject matter which was disclosed by the Ross patent and relied upon to reject the pending claims of the present application and that Mr. Ross derived this subject matter from Applicant. Accordingly, for the reasons set forth hereinbefore, the Ross patent is not a proper prior art reference.

b. Response to Arguments by PTO

In asserting that the '770 patent is not a valid prior art reference, Applicant relies in part upon *In re DeBaun*, which states that “an applicant’s own work, even though publicly disclosed prior to his application, may not be used against him as a reference, absent the existence of a time bar.” 214 U.S.P.Q. at 935. However, in the final Office Action mailed on July 26, 2001, it is asserted by the Patent Office that the law set forth in *In re DeBaun* “only applies to the same applicant for the patent and the application.” Applicant respectfully traverses this interpretation of *In re DeBaun* by the Patent Office.

In the case of *In re Mathews*, Dewey filed a patent application for a time delay protective device for an electronic circuit. 161 U.S.P.Q. 276 (C.C.P.A. 1969). The patent application (which issued as U.S. Patent No. 3,105,920) included unclaimed subject matter derived from Mathews, who was a co-worker of Dewey. Later, Mathews filed a patent application pertaining to the unclaimed subject matter disclosed in the earlier filed *Dewey* patent. The Court found that the *Dewey* patent included a “full disclosure of the invention now claimed by Mathews.” *Id.* at 277 (Emphasis Added).

Since the subject matter derived by Mathews was not claimed in the *Dewey* patent, Mathews was not named as an inventor in the *Dewey* patent. However, the Court held that the *Dewey* patent could **not** be applied as a prior art reference against the *Mathews* application, “since Dewey derived his knowledge (of the relevant subject matter) from Mathews.” *Id.* at 278. Therefore, the *Dewey* patent was not considered to be a prior art reference to the *Mathews* patent application even though: (a) the *Dewey* patent was filed before the effective filing date of the *Mathews* patent application, and (b) Mathews was **not** an inventor in the *Dewey* patent (*i.e.*, the *Dewey* patent and the *Mathews* patent application properly named different inventive entities).



Accordingly, there is no requirement that an applicant must establish that he is a named inventor of a prior patent to remove the patent as a prior art reference via an affidavit/declaration under 37 C.F.R. §1.132.

In fact, M.P.E.P. §2136.05 states that “(w)hen a prior U.S. patent is not a statutory bar, a 35 U.S.C. 102(e) rejection can be overcome by antedating the filing date of the U.S. patent under 37 C.F.R. §1.131 *or by submitting an affidavit or declaration under 37 C.F.R. §1.132 establishing that the relevant disclosure is applicant’s own work.*” (Emphasis added). There is no requirement in M.P.E.P. §2136.05 for the applicant to be named as an inventor in the prior U.S. patent.

Furthermore, the Court of Customs and Patent Appeals has stated in the case of *In re Land and Rogers* that:

there are two conditions expressed in section 102(e): (1) the application for the reference patent must have been by one who is legally “another” and (2) the filing date must be “before the invention \* \* \* by the applicant \* \* \*.” When the 102(e) reference patentee got knowledge of the applicant’s invention from him, as by being associated with him, \* \* \* and *thereafter* describes it, he necessarily files the application *after* the applicant’s invention date and the patent as a “reference” does not evidence that the invention, when made, was already known to others. (Footnote omitted.) Evidence of such a state of facts, whatever its form, must be considered. 151 U.S.P.Q. 621, 633 (1966); see, also, *Mathews* at 279.

Noting that there is no mention of a requirement in *Land* for an applicant to be named as an inventor in a prior patent to overcome the prior patent as a reference, Applicant submits that the aforementioned interpretation of *In re DeBaun* by the Patent Office incorrectly focuses on the “by another” requirement of 35 U.S.C. §102(e) instead of the “before the invention” requirement. In focusing on the “before the invention” requirement, the “proper subject of inquiry” is “*who* invented the subject matter disclosed by (the reference) which was relied on to support the rejection.” *Id.* at 633 n. 11; *see also, DeBaun* at 935. In other words, the proper inquiry is not who first disclosed the subject matter but rather who invented the subject matter. Consequently, to

overcome a prior art reference under 35 U.S.C. §102(e), all that needs to be shown (in the absence of a time bar) is that the subject matter relied on by the Patent Office to reject the applicant's patent application was derived from the applicant, and there is no requirement that an applicant be a named inventor of the prior art reference.

It is further asserted by the Patent Office in the final Office Action that Applicant must show that he and Ross were co-workers to remove the *Ross* patent as prior art under 37 C.F.R. §1.132. In this regard, to remove a prior art reference under 37 C.F.R. §1.132 in the absence of a time bar, it is only necessary to show that the named inventor of the prior patent derived his knowledge of the relevant subject matter from the applicant. The applicant and prior inventor being co-workers is only one scenario in which this may happen, and *Mathews* should not be interpreted as requiring evidence showing that the applicant was a co-worker of the named inventor of the prior patent. In fact, it is asserted in M.P.E.P. §2136.05 that:

when the unclaimed subject matter of a patent is applicant's own invention, applicant may overcome a *prima facie* case based on the patent by showing that the patent disclosure is a description of applicant's own previous work. Such a showing can be made by proving that the patentee was associated with applicant (*e.g.* worked for the same company) and learned of applicant's invention from applicant. (Emphasis added).

Therefore, it is recognized by the M.P.E.P. that the applicant being a co-worker of the named inventor is only an *example* of a scenario in which the named inventor may be "associated" with an applicant so that the named inventor may derive subject matter from the applicant. Accordingly, Applicant respectfully asserts that there are other scenarios in which the named inventor may derive subject matter from the applicant, and it is not necessary for the Applicant to submit evidence showing that the Applicant and Ross were co-workers to remove the *Ross* patent as prior art references pursuant to *In re Mathews*.

In addition, even though Applicant traverses the foregoing “co-worker” requirement, Applicant submits that the “co-worker” requirement is satisfied by the facts of the present case. In this regard, Exhibits A - F submitted along with the First Response filed on July 31, 2000, show that Applicant and Ross were attempting to form a business together and that Ross was responsible for raising money for the business. Therefore, Applicant submits that he and Ross were, in fact, “co-workers.”

It is further asserted in the final Office Action that Applicant must show that he jointly invented the relevant subject matter disclosed in the ‘770 patent to have the ‘770 patent removed as a prior art reference pursuant there has to be an “indication that the portions of the references relied on disclosed anything they did jointly.” For the following reasons, Applicant fails to see how the foregoing statements in the Office Action show that the rejections in the outstanding Office Action are proper.

First, Applicant agrees that the “issue turns on what the evidence of record shows as to who invented the subject matter.” In this regard, Applicant asserts that the evidence of record shows (1) that Applicant invented the subject matter disclosed by the *Ross* patent and used to reject the pending claims and (2) that Ross derived this subject matter from Applicant. Thus, as previously set forth hereinabove, *Ross* is not a valid prior art reference.

Second, Applicant admits that the rejection in *Land* was affirmed because there “was no indication that the portions of the references relied on disclosed anything they did jointly.” However, in *Land*, a joint application filed by Rogers and Land was being rejected by one or more patents naming Land as the only inventor and one or more patents naming Rogers as the only inventor. Further, as previously set forth herein numerous times, for *DeBaun*, *Mathews*, and M.P.E.P. §2136.05 to be applicable, the applicant of a later filed application must show that he

invented the subject matter being used to reject his application and that the named inventor of the asserted prior art reference derived the subject matter from the applicant. Therefore, applying the foregoing rule to the situation in *Land*, Rogers and Land had to show that the subject matter being used to reject their later filed joint application was invented by them jointly. If this was true, then the relevant subject matter disclosed in the patents to Rogers individually and in the patents to Land individually is considered to have been derived from the applicant (*i.e.*, both Rogers and Land) of the later filed joint application. As a result, the individual patents to Land and to Rogers could be removed as prior art references under *DeBaun*, *Mathews*, and M.P.E.P. §2136.05. However, since the Court found that the foregoing was not true (*i.e.*, since the Court found that Land and Rogers did not jointly invent the relevant subject matter), the Court held that the relevant subject matter was not derived from the applicant (*i.e.*, both Rogers and Land) but instead was derived from Rogers individually and from Lands individually. Therefore, the Court properly held that the rule of law set forth in *DeBaun*, *Mathews*, and M.P.E.P. §2136.05 should not be applied.

However, in the instant case, the Applicant is not a joint inventor, unlike the applicant in the *Lands* case. Thus, it is not necessary to show that the Applicant jointly invented the relevant subject matter disclosed in *Ross* in order to have *Ross* removed as a prior art reference pursuant to *DeBaun*, *Mathews*, and M.P.E.P. §2136.05. Indeed, applying the rule of law set forth by *Land* to the facts of the instant case, Applicant must show that he *individually* invented the subject matter being used to reject the pending claims and that Ross derived this subject matter from the Applicant. If this is true, then *Ross*, according to the law set forth in *Land* and M.P.E.P. §2136.05, must be removed as a prior art reference in the absence of a time bar. Hence, even though the Court decided not to remove the prior patents as prior art references in *Land*, there is nothing in the

holding of the *Land* case to suggest that *DeBaun, Mathews*, and M.P.E.P. §2136.05 should not be applied in the instant situation.

It is additionally asserted by the Patent Office in the final Office Action that

While MPEP 2136.05 does not mention that the application has to be named as an inventor in a prior US Patent to remove this reference as prior art by an affidavit/declaration, MPEP 715 only refers to “joint application or patent” or “commonly owned application or patent.”

Finally, as stated in MPEP 716, “It is the responsibility of the primary examiner to personally review and decide whether affidavits or declarations submitted under 37 CFR 1.132 for the purpose of traversing grounds of rejection are responsible to the rejection and present sufficient facts to overcome the rejection.

Applicant submits that M.P.E.P. §§715 and 716 do not cover all situations and fact patterns upon which an applicant can remove a reference as prior art. Indeed, whether or not M.P.E.P. §§715 and 716 refer only to joint patents is not germane as to whether or not *Ross* can be removed as a prior art reference pursuant to rules set forth by *DeBaun, Mathews*, and M.P.E.P. §2136.05. Thus, Applicant fails to see how the foregoing assertions in the Office Action tends to support the Patent Office’s position that *Ross* should not be removed as a prior art reference even though the evidence of record clearly shows that requirements set forth by *DeBaun, Mathews*, and M.P.E.P. §2136.05 have been satisfied in the instant case.

It is also asserted in the final Office Action that:

On page 4 of the response, applicant contended that “there is no requirement that an applicant must establish that [he] is a named inventor of a prior patent to remove the patent as prior art reference via an affidavit/declaration under 37 CFR 1.132.” While this may be true, it must [be] clear of record that the patent application and the prior art reference is [sic] commonly owned or assigned. Which is not the case in the present situation. Not only the present application and the prior art reference name different inventors and different inventive entities, they are not commonly owned or assigned.

...

*Applicant can filed [sic] an affidavit to overcome the rejection. However, this can only happen in the case where i) applicant is one of a group of inventors of the patent or ii) the application and the patent are assigned to the same assignee.*

Applicant respectfully traverses the above conclusions and asserts that there is no basis in the case law for requiring the Applicant to show either of the foregoing contingencies. As set forth hereinabove, the law set forth in *Mathews* shows that an applicant does not have to be a named inventor of a patent to remove the patent as a prior art reference via a Declaration under 37 C.F.R. §1.132. Further, the verdict in *Mathews* does not appear to turn on whether or not the patent and the application are assigned to the same entity. Indeed, as set forth hereinabove, the rationale behind removing a patent as a prior art reference when the patent includes subject matter derived from an applicant is directed toward the fact that the applicant, not the named inventor of the patent, is the inventor of the relevant subject matter. See *Land* at 633 and *Mathews* at 278 in which the Court in *Mathews* specifically held that the applicant was the “the original, first, and sole inventor.” Further, whether or not an application and a patent are assigned to the same entity is irrelevant in inventorship issues. Thus, whether or not Applicant and Ross have assigned their interest to the same entity should be irrelevant in determining whether or not Applicant’s declarations may be considered to overcome *Ross* pursuant to the foregoing case law. As a result, the requirement in the Office Action for the Applicant to show either (1) that he is a named inventor of the *Ross* patent or (2) that the present application and the *Ross* patent are assigned to the same entity does not comport with the case law set forth hereinabove.

The Patent Office further asserts in the final Office Action that:

*Applicant submitted a plurality of exhibits in support to show that the subject matter disclosed by Ross and used in the office action to reject the claims is the product of applicant’s own previous work. Applicant then asserts that the*

*Ross patent is not prior art.*

*The mere fact that applicant has submitted several exhibits including a declaration filed by applicant stating that applicant is a "co-inventor" of the patents to Ross and that applicant invented the subject matter disclosed in the patents to Ross, is not a basis to remove Ross patents as prior art and withdrawn [sic] the rejections.*

*The examiner has considered [sic] and reviewed [sic] all the documents (exhibits) presented before him. However, based on the limited information presented herein, the examiner is not able to make a decision as to withdrawn [sic] the rejections. Applicant would need a disclaimer from Mr. Ross and/or the Assignee of the Ross patents affirming that applicant's statement is true or any other evidence showing such.*

Applicant respectfully asserts that there is nothing in the case law or the M.P.E.P. that requires an applicant to show an admission from the inventor or owner of a patent in order to overcome the patent pursuant to *DeBaun, Mathews*, and M.P.E.P. §2136.05. Thus, Applicant asserts that the declarations and other evidence submitted by him are sufficient for showing that Ross derived from the Applicant the subject matter being used to reject the pending claims of the instant application. Therefore, the declarations and other evidence submitted by the Applicant are sufficient for overcoming *Ross* pursuant to *DeBaun, Mathews*, and M.P.E.P. §2136.05.

For the foregoing reasons, Applicant asserts that *Ross* is not a valid prior art reference to the instant application as alleged in the Office Action. Therefore, the rejection to pending claims 1-11, 13, 14, 16-23, 27-32, 35-39, and 41-55 is improper and should be withdrawn.

### **3. Group 3**

A proper rejection of a claim under 35 U.S.C. §103 as being obvious based upon a combination of references must disclose, teach, or suggest, either implicitly, all elements, features, or steps of the claim at issue. *See, e.g., In re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988); *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981). Furthermore, in order for a claim to

be properly rejected under 35 U.S.C. §103, the combined teachings of the prior art references must suggest all the features of the claimed invention to one of ordinary skill in the art. See, *e.g.*, *In Re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988), and *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981). In this regard, it is impermissible “simply to engage in a hindsight reconstruction of the claimed invention.” *In re Gorman*, 933 F.2d 982, 18 U.S.P.Q.2d 1885 (Fed. Cir. 1991).

a. Claim 1

Claim 1 presently stands rejected under 35 U.S.C. §103 as allegedly being unpatentable over *Ross* in view of *Bolger*. Pending claim 1 includes the following features:

**a data manager configured to receive an activation request, said activation request including a vehicle indicator and a location indicator . . . to track travel of said vehicle based on travel data received from said vehicle, said travel data identifying said vehicle, and to automatically transmit a message in response to a determination that said vehicle is within said identified proximity; and**

**a communications interface configured to receive said activation request from a user at a remote location, to automatically transmit said activation request to said data manager, to receive said message from said data manager, and to transmit said message to user.**

Applicant respectfully submits that the prior art of record is inadequate to suggest the foregoing features and that the rejection to pending claim 1 is improper and should be withdrawn.

In this regard, *Ross* teaches that the travel of a vehicle should be monitored by a controller located on the vehicle. When the vehicle is within a predetermined time from a delivery location, the controller initiates a call to a selected recipient to warn the selected recipient of the impending arrival of the vehicle. See col. 4, line 59, through col. 5, line 6. However, the controller telephone



call is initiated by the vehicle controller via a communication apparatus, which is located on the vehicle and calls the selected recipient directly. There is no suggestion that the controller receives a vehicle indicator and location indicator from a user, as described by pending claim 1. As a result, *Ross* utilizes a vehicle monitoring system whereby users cannot request information about the status of specific vehicles relative to specific locations. This is a significant drawback in applications that may need a user at a remote location to easily activate service for monitoring of a particular vehicle at a particular stop. Therefore, the present invention is a significant improvement over the system taught by *Ross*.

In addition, the present invention, as described by pending claim 1, describes an automated system capable of tracking vehicles and of reporting when a particular vehicle is within a specified proximity of a particular location. The reporting is *automatically* activated in response to an activation request, from a remote user, that includes a vehicle indicator and a location indicator. The vehicle indicator identifies a vehicle that the remote user would like tracked, and the location indicator identifies a location that is used to determine when a notification message should be transmitted to the remote user. For example, when the system of the present invention determines that the vehicle is within a certain proximity of the identified location, the system may be configured to transmit a notification message to the remote user in order to notify the user of impending arrival of the vehicle at a particular destination. Since the activation of the reporting is automatic, the system is capable of tracking a large number of vehicles and/or of handling a large number of activation requests. Applicant has reviewed *Ross* and can find nothing in *Ross* to indicate that reporting of vehicle arrivals in *Ross* is automatic in response to activation requests from remote users.

It is, however, asserted in the Office Action in regard to *Ross* that it would be obvious in view of *Bolger* to allow users to request for a specific vehicle or particular location, since *Bolger* suggests a transit system wherein a user requests transit service at a request terminal. However, *Bolger* fails to teach or suggest that a user can submit a request for a specific vehicle, for in *Bolger*, a user makes a request for service, and then a computer determines which vehicle is dispatched to a user. Also, unlike Applicant's invention, *Bolger* suggests that a user may only request service at the location where the request terminal is located. Hence, Applicant submits that to extend the teachings of *Ross* in view of *Bolger* to reject pending claim 1 is impermissible hindsight reconstruction of Applicant's invention.

Furthermore, in addition to the reasons set forth above, Applicant submits that *Ross* in view of *Bolger* is inadequate to reject claim 1 under 35 U.S.C. §103 because the proposed combination fails to disclose at least the features of a "data manager" that tracks travel of a vehicle "based on travel data received from said vehicle, ***said travel data identifying said vehicle***" and transmits a message to a remote user when the vehicle is within a specified proximity, as described by pending claim 1. (Emphasis added).

In this regard, the vehicle controller 10 of *Ross* is configured to track travel of a vehicle and to transmit a notification message when an estimated time of arrival of the vehicle is less than a predetermined interval. *See* col. 4, line 53, through col. 5, line 8. Since the controller 10 is located on the vehicle being tracked by the controller 10, there is no need for data identifying the vehicle to be included in the travel data used by the controller 10 to track the vehicle. In particular, data from receiver 18 is used by the controller 10 to determine the location of the vehicle, and all of the data received by the controller 10 from the receiver 18 pertains to the vehicle being tracked by the controller 10. As a result, there is nothing in *Ross* to indicate that the signals received from receiver

18 (*i.e.*, the signals used by controller 10 to track travel of the vehicle) identifies the vehicle, as described by pending claim 1. Therefore to extend the teachings of *Ross* in view of *Bolger* to reject pending claim 1 is impermissible hindsight reconstruction of Applicant's invention.

**b. Claims 2-11, and 41-42**

Because independent claim 1 is believed to be allowable over the prior art of record, dependent claims 2-11 and 41-42 (which depend from independent claim 1) are allowable as a matter of law for at least the reason that dependent claims 2-11 and 41-42 contain all the elements and features of independent claim 1.

**c. Claims 13**

Claim 13 presently stands rejected under 35 U.S.C. §103 as allegedly being unpatentable over *Ross* in view of *Bolger*. However, similar to pending claim 1, claim 13 presently includes the feature of a data manager configured to receive a vehicle indicator and a location indicator from a user at a remote location. For the same reasons set forth hereinabove in the arguments for allowance of claim 1, Applicant respectfully submits that the rejection to claim 13, as presently set forth, is improper and should be withdrawn.

**d. Claim 14, 16-22, and 43-44**

Claims 14, 16-22, and 43-44 presently stand rejected under 35 U.S.C. §103 as allegedly being obvious by *Ross* in view of *Bolger*. Applicant submits that the pending dependent claims 14, 16-22, and 43-44 contain all the features of their respective independent claim 13. Since claim 13

should be allowed, as argued hereinabove, pending dependent claims 14, 16-22, and 43-44 should be allowed as a matter of law for at least this reason. *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

**e. Claim 23**

Claim 23 presently stands rejected under 35 U.S.C. §103 as allegedly being unpatentable over *Ross* in view of *Bolger*. However similar to pending claim 1, claim 23 presently includes the feature of receiving a vehicle indicator and a location indicator from a user at a remote location. For the same reasons set forth hereinabove in the arguments for allowance of claim 1, Applicant respectfully submits that the rejection to claim 23, as presently set forth, is improper and should be withdrawn.

**f. Claims 27-30**

Claims 27-30 presently stand rejected under 35 U.S.C. §103 as allegedly being obvious by *Ross* in view of *Bolger*. Applicant submits that the pending dependent claims 27-30 contain all the features of their respective independent claim 23. Since claim 23 should be allowed, as argued hereinabove, pending dependent claims 27-30 should be allowed as a matter of law for at least this reason. *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

**g. Claim 31**

Claim 31 presently stands rejected under 35 U.S.C. §103 as allegedly being unpatentable over *Ross* in view of *Bolger*. However similar to pending claim 1, claim 31 presently includes the feature of receiving a vehicle indicator and a location indicator from a user at a remote location. For

the same reasons set forth hereinabove in the arguments for allowance of claim 1, Applicant respectfully submits that the rejection to claim 31, as presently set forth, is improper and should be withdrawn.

**h. Claims 32 and 35-38**

Claims 32 and 35-38 presently stand rejected under 35 U.S.C. §103 as allegedly being unpatentable over *Ross* in view of *Bolger*. Applicant submits that the pending dependent claims 32 and 35-38 contain all the features of their respective independent claim 31. Since claim 31 should be allowed, as argued hereinabove, pending dependent claims 32 and 35-38 should be allowed as a matter of law for at least this reason. *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

**i. Claim 39**

Claim 39 presently stands rejected under 35 U.S.C. §103 as allegedly being unpatentable over *Ross* in view of *Bolger*. However, similar to pending claim 1, claim 39 presently includes the feature of receiving a vehicle indicator and a location indicator from a user at a remote location. For the same reasons set forth hereinabove in the arguments for allowance of claim 1, Applicant respectfully submits that the rejection to claim 39, as presently set forth, is improper and should be withdrawn.

**j. Claim 45**

Claim 45 presently stands rejected under 35 U.S.C. §103 as allegedly being unpatentable over *Ross* in view of *Bolger*. However, similar to pending claim 1, claim 45 presently includes the feature of data manager configured to receive a vehicle indicator and a location indicator from a

user at a remote location. For the same reasons set forth hereinabove in the arguments for allowance of claim 1, Applicant respectfully submits that the rejection to claim 45, as presently set forth, is improper and should be withdrawn.

**k.     Claims 46-48**

Claims 46-48 presently stand rejected under 35 U.S.C. §103 as allegedly being obvious by *Ross* in view of *Bolger*. Applicant submits that the pending dependent claims 46-48 contain all the features of their respective independent claim 45. Since claim 45 should be allowed, as argued hereinabove, pending dependent claims 46-48 should be allowed as a matter of law for at least this reason. *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

**l.     Claim 49**

Claim 49 presently stands rejected under 35 U.S.C. §103 as allegedly being unpatentable over *Ross* in view of *Bolger*. However similar to pending claim 1, claim 49 presently includes the feature of data manager configured to receive a vehicle indicator and a location indicator from a user at a remote location. For the same reasons set forth hereinabove in the arguments for allowance of claim 1, Applicant respectfully submits that the rejection to claim 49, as presently set forth, is improper and should be withdrawn.

**m.     Claim 50-52**

Claims 50-52 presently stand rejected under 35 U.S.C. §103 as allegedly being obvious by *Ross* in view of *Bolger*. Applicant submits that the pending dependent claims 50-52 contain all the features of their respective independent claim 49. Since claim 49 should be allowed, as argued

hereinabove, pending dependent claims 50-52 should be allowed as a matter of law for at least this reason. *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

**n. Claim 53**

Claim 53 presently stands rejected under 35 U.S.C. §103 as allegedly being unpatentable over *Ross* in view of *Bolger*. However similar to pending claim 1, claim 53 presently includes the feature of receiving a vehicle indicator and a location indicator from a user at a remote location. For the same reasons set forth hereinabove in the arguments for allowance of claim 1, Applicant respectfully submits that the rejection to claim 53, as presently set forth, is improper and should be withdrawn.

**o. Claim 54-55**

Claims 54-55 presently stand rejected under 35 U.S.C. §103 as allegedly being obvious by *Ross* in view of *Bolger*. Applicant submits that the pending dependent claims 54-55 contain all the features of their respective independent claim 53. Since claim 53 should be allowed, as argued hereinabove, pending dependent claims 54-55 should be allowed as a matter of law for at least this reason. *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

**4. Group 4**

A proper rejection of a claim under 35 U.S.C. §103 as being obvious based upon a combination of references must disclose, teach, or suggest, either implicitly, all elements, features, or steps of the claim at issue. *See, e.g., In re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988); *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981). Furthermore, in order for a claim to

be properly rejected under 35 U.S.C. §103, the combined teachings of the prior art references must suggest all the features of the claimed invention to one of ordinary skill in the art. See, *e.g.*, *In Re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988), and *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981). In this regard, it is impermissible “simply to engage in a hindsight reconstruction of the claimed invention.” *In re Gorman*, 933 F.2d 982, 18 U.S.P.Q.2d 1885 (Fed. Cir. 1991).

**a. Claim 4**

Claim 4 presently stands rejected under 35 U.S.C. §103 as allegedly being unpatentable over *Ross* in view of *Bolger*. Pending claim 4 includes the following feature:

***The system of claim 1, wherein said proximity is defined by distance.***

Applicant respectfully submits that the prior art of record is inadequate to suggest the foregoing features and that the rejection to pending claim 4 should therefore be withdrawn.

In this regard, *Ross* teaches that the travel of a vehicle should be monitored by a controller located on the vehicle which compares the estimated time of arrival of a vehicle with a predetermined interval of time. See col. 6, lines 40-45. When the vehicle is within a predetermined time from a delivery location, the controller initiates a call to a selected recipient to warn the selected recipient of the impending arrival of the vehicle. See col. 4, line 59, through col. 5, line 6. There is no suggestion that the controller notifies a recipient when a vehicle is within a predetermined distance or proximity to a delivery location. Hence, Applicant submits that to extend the teachings of *Ross* to reject pending claim 4 is impermissible hindsight reconstruction of Applicant’s invention.



**b. Claim 5**

Claim 5 presently stands rejected under 35 U.S.C. §103 as allegedly being unpatentable over *Ross* in view of *Bolger*. Pending claim 5 includes the following feature:

***The system of claim 1, wherein said identified proximity is defined by a predetermined location along said route of travel.***

Applicant respectfully submits that the prior art of record is inadequate to suggest the foregoing features and that the rejection to pending claim 5 should, therefore be withdrawn.

In this regard, *Ross* teaches that the travel of a vehicle should be monitored by a controller located on the vehicle which compares the estimated time of arrival of a vehicle with a predetermined interval of time. *See* col. 6, lines 40-45. When the vehicle is within a predetermined time from a delivery location, the controller initiates a call to a selected recipient to warn the selected recipient of the impending arrival of the vehicle. *See* col. 4, line 59, through col. 5, line 6. There is no suggestion that the controller notifies a recipient when a vehicle is at a predetermined location. Hence, Applicant submits that to extend the teachings of *Ross* in view of *Bolger* to reject pending claim 5 is impermissible hindsight reconstruction of Applicant's invention.

**c. Claim 19**

Claim 19 presently stands rejected under 35 U.S.C. §103 as allegedly being unpatentable over *Ross* in view of *Bolger*. However similar to pending claim 4, claim 19 presently includes the feature wherein the proximity is defined by distance. For the same reasons set forth hereinabove in the arguments for allowance of claim 4, Applicant respectfully submits that the rejection to claim 19, as presently set forth, is improper and should be withdrawn.

d. **Claim 20**

Claim 20 presently stands rejected under 35 U.S.C. §103 as allegedly being unpatentable over *Ross* in view of *Bolger*. However similar to pending claim 5, claim 20 presently includes the feature wherein the proximity is defined by a predetermined location along a route of travel. For the same reasons set forth hereinabove in the arguments for allowance of claim 5, Applicant respectfully submits that the rejection to claim 20, as presently set forth, is improper and should be withdrawn.

e. **Claim 39**

Claim 39 presently stands rejected under 35 U.S.C. §103 as allegedly being unpatentable over *Ross* in view of *Bolger*. However similar to pending claim 5, claim 39 presently includes the feature wherein the proximity is defined by a predetermined location along a route of travel. For the same reasons set forth hereinabove in the arguments for allowance of claim 5, Applicant respectfully submits that the rejection to claim 39, as presently set forth, is improper and should be withdrawn.

5. **Group 5**

A proper rejection of a claim under 35 U.S.C. §103 as being obvious based upon a combination of references must disclose, teach, or suggest, either implicitly, all elements, features, or steps of the claim at issue. *See, e.g., In re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988); *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981). Furthermore, in order for a claim to be properly rejected under 35 U.S.C. §103, the combined teachings of the prior art references must suggest all the features of the claimed invention to one of ordinary skill in the art. *See, e.g., In Re*

*Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988), and *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981). In this regard, it is impermissible “simply to engage in a hindsight reconstruction of the claimed invention.” *In re Gorman*, 933 F.2d 982, 18 U.S.P.Q.2d 1885 (Fed. Cir. 1991).

a. **Claim 10**

Claim 10 presently stands rejected under 35 U.S.C. §103 as allegedly being unpatentable over *Ross* in view of *Bolger*. The present invention, as defined by pending claim 10, includes a data manager that assumes a vehicle travels according to a predetermined rate. In other words, the data manager assumes that the vehicle is on schedule. As a result, when the vehicle is actually on schedule, the data manager can be aware of the vehicle’s actual location without the vehicle manager having to transmit a message to the base station manager. When the vehicle is off schedule, a data manager on the vehicle transmits travel data to the data manager described by pending claim 10 so that the data manager of claim 10 is aware that the vehicle is off schedule. This travel data is preferably indicative of the actual location of the vehicle. Therefore, the data manager of claim 10 can be aware of the vehicle’s location with a minimal amount of communication messages transmitted between the vehicle and the data manager, especially when the vehicle is on schedule for at least a portion of the vehicle’s route.

There is nothing in *Ross* to indicate that the system described by *Ross* utilizes such optimizing techniques. Therefore, *Ross* fails to disclose at least the features of a “vehicle manager” configured to “transmit said travel data in response to a determination that said vehicle is off schedule” and a data manager “configured to assume that said vehicle is on schedule unless said data manager receives said travel data transmitted from said vehicle.” Inasmuch as *Bolger* does

not suggest the aforementioned features either, Applicant respectfully submits that *Ross* fails to disclose each feature of pending claim 10 and to extend the teachings of *Ross* in view of *Bolger* to reject pending claim 10 is impermissible hindsight reconstruction of Applicant's invention.

**b. Claim 44, 48, and 52**

Claim 44, 48, and 52 presently stand rejected under 35 U.S.C. §103 as allegedly being unpatentable over *Ross* in view of *Bolger*. However, similar to pending claim 10, claims 44, 48, and 52 presently include the feature of a data manager that assumes a vehicle travels at a predetermined rate. For the same reasons set forth hereinabove in the arguments for allowance of claim 10, Applicant respectfully submits that the rejection to claims 44, 48, and 52, as presently set forth, is improper and should be withdrawn.

**6. Group 6**

A proper rejection of a claim under 35 U.S.C. §103 as being obvious based upon a combination of references must disclose, teach, or suggest, either implicitly, all elements, features, or steps of the claim at issue. *See, e.g., In re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988); *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981). Furthermore, in order for a claim to be properly rejected under 35 U.S.C. §103, the combined teachings of the prior art references must suggest all the features of the claimed invention to one of ordinary skill in the art. *See, e.g., In Re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988), and *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981). In this regard, it is impermissible "simply to engage in a hindsight reconstruction of the claimed invention." *In re Gorman*, 933 F.2d 982, 18 U.S.P.Q.2d 1885 (Fed. Cir. 1991).

a. **Claim 27**

Claim 27 presently stands rejected under 35 U.S.C. §103 as allegedly being unpatentable over *Ross* in view of *Bolger*. The present invention, as defined by pending claim 27, includes the feature of a controller that receives contact information from a user. Applicant respectfully submits that the prior art of record is inadequate to suggest the foregoing features and that the rejection to pending claim 27 should therefore be withdrawn.

In this regard, *Ross* teaches that the travel of a vehicle should be monitored by a controller located on the vehicle. However, there is no suggestion that the controller receives contact information from a user, as described by pending claim 27. Inasmuch as *Bolger* does not suggest the aforementioned features either, Applicant submits that *Ross* fails to disclose at least the features of pending claim 27 highlighted hereinabove, and to extend the teachings of *Ross* in view of *Bolger* to reject pending claim 27 is impermissible hindsight reconstruction of Applicant's invention.

b. **Claim 35, 41, 46, 50, and 55**

Claims 35, 41, 46, 50, and 55 presently stand rejected under 35 U.S.C. §103 as allegedly being unpatentable over *Ross* in view of *Bolger*. However, similar to pending claim 27, claims 35, 41, 46, 50, and 55 presently include the feature of a controller that receives contact information from a user. For the same reasons set forth hereinabove in the arguments for allowance of claim 27, Applicant respectfully submits that the rejection to claims 35, 41, 46, 50 and 55, as presently set forth, is improper and should be withdrawn.

### **Response to Double Patenting Rejections**

Claims 1-11, 13, 14, 16-23, 27-32, 35-39, and 41-55 presently stand provisionally rejected under the judicially created doctrine of double patenting over claims 1-30 of copending Application No. 09/395,497 and claims 1-36 of copending Application No. 09/163,958. Furthermore, claims 1-11, 13, 14, 16-23, 27-32, 35 and 36 presently stand provisionally rejected under the judicially created doctrine of double patenting over claims 1-21 and 23-49 of copending Application No. 08/852,119. Applicant respectfully traverses these provisional rejections and asserts that the claims of the foregoing applications do not suggest each feature of pending claims 1-11, 13, 14, 16-23, 27-32, 35-39, and 41-55. Noting that the foregoing rejections are provisional, Applicant requests that the rejections be withdrawn when the present application is otherwise in a condition for allowance pursuant to M.P.E.P. §823.

Furthermore, claims 1-11, 13, 14, 16-23, 27-32, 35-39, and 41-55 presently stand rejected under the judicially created doctrine of double patenting over claims 1-16 of U.S. Patent No. 5,623,260, claims 1-15 of U.S. Patent No. 5,657,010, and claims 1-80 of U.S. Patent No. 5,668,543. However, Applicant submits that the present application claims priority to copending Application No. 08/852,119. Further, Application No. 08/852,119 claims priority to U.S. Patent No. 5,623,260, U.S. Patent No. 5,657,010, and U.S. Patent No. 5,668,543. Therefore, pursuant to 35 U.S.C. §154, any patent that will issue from the present application will have a term that will not exceed any of the terms of the foregoing patents, and as a result, there should be no unjustified term extension on a “right to exclude” that is already granted in any of the aforementioned patents. As such, the double patenting rejections to the pending claims of the present application are improper, and Applicant respectfully requests that the double patenting rejections be withdrawn.

**CONCLUSION**

Applicant respectfully requests that the Board of Appeals reverse the Examiner's rejections of all pending claims 1-11, 13, 14, 16-23, 27-32, 35-39, and 41-55 for the reasons indicated.

Respectfully submitted,

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Docket No.: 50711-1028

## APPENDIX TO THE APPEAL BRIEF UNDER 37 C.F.R. §1.192

The Appendix is incorporated into the foregoing Appeal Brief under 37 C.F.R. §1.192.

### THE CLAIMS

1. A system for automatically reporting upon travel status of vehicles in response to activation requests by users at remote locations, comprising:

a data manager configured to receive an activation request, said activation request including a vehicle indicator and a location indicator, said data manager further configured to automatically correlate said vehicle indicator with a vehicle and said location indicator with a location along a route of travel of said vehicle, to automatically identify a proximity based on said location indicator, to track travel of said vehicle based on travel data received from said vehicle, said travel data identifying said vehicle, and to automatically transmit a message in response to a determination that said vehicle is within said identified proximity; and

a communications interface configured to receive said activation request from a user at a remote location, to automatically transmit said activation request to said data manager, to receive said message from said data manager, and to transmit said message to said user.

2. The system of claim 1, wherein said communications interface is one or more telephone interface devices.

3. The system of claim 1, wherein said identified proximity is defined by time.

4. The system of claim 1, wherein said identified proximity is defined by distance.

5. The system of claim 1, wherein said identified proximity is defined by a predetermined location along said route of travel.

6. The system of claim 1, wherein said vehicle is a bus and said location is a bus stop.

7. The system of claim 1, wherein said vehicle indicator identifies said vehicle and said location indicator identifies said location.

8. The system of claim 1, further comprising a vehicle manager configured to transmit travel data to said data manager via a control channel of a cellular network.

9. The system of claim 1, further comprising a vehicle manager configured to transmit said travel data to said data manager via a voice channel of a cellular network.



10. The system of claim 42, wherein said vehicle manager is configured to transmit said travel data to said data manager] in response to a determination that said vehicle is off schedule, and wherein said data manager, in tracking said vehicle, is configured to assume that said vehicle is on schedule unless said data manager receives said travel data transmitted from said vehicle.

11. The system of claim 1, wherein said data manager further comprises a monitoring mechanism configured to receive said travel data from said vehicle, to compare said travel data with a coordinate value indicating a proximity of said location, and to correlate said travel data with said coordinate value based on said vehicle indicator and said location indicator.

12. (Canceled).

13. A system, comprising:  
a data manager configured to receive a vehicle indicator and a location indicator, to identify a proximity based on said location indicator, to identify a vehicle based on said vehicle indicator, to monitor travel of said vehicle, to analyze travel data indicative of whether said vehicle is within said proximity, to determine whether to transmit a message based on said travel data and said vehicle indicator, and to transmit said message in response to a determination that said vehicle is within said proximity; and  
a communications interface configured to receive said vehicle indicator and said location indicator from a user at a remote location, to transmit said vehicle indicator and said location indicator to said data manager, to receive said message from said data manager, and to transmit said message to said user.

14. The system of claim 13, wherein said communications interface is one or more telephone interface devices.

15. (Canceled).

16. The system of claim 13, further comprising a vehicle manager configured to transmit said travel data to said data manager via a control channel of a cellular network.

17. The system of claim 13, further comprising a vehicle manager configured to transmit said travel data to said data manager via a voice channel of a cellular network.

18. The system of claim 13, wherein said identified proximity is defined by time.

19. The system of claim 13, wherein said identified proximity is defined by distance.

20. The system of claim 13, wherein said identified proximity corresponds with a predetermined location along said route of travel.

21. The system of claim 13, wherein said vehicle is a bus and said location is a bus stop.

22. The system of claim 13, wherein said vehicle indicator identifies said vehicle and said location indicator identifies said location.

23. A system for automatically reporting upon travel status of vehicles in response to activation requests by users at remote locations, comprising:  
means for receiving an activation request from a user at a remote location, said activation request including a vehicle indicator and a location indicator;  
means for identifying a vehicle based on said vehicle indicator;  
means for identifying a location based on said location indicator;  
means for specifying a proximity based on said location;  
means for monitoring travel of said vehicle;  
means for analyzing travel data indicative of whether said vehicle is within said specified proximity;  
means for determining whether to transmit a message to said user based on said analyzing means and said vehicle indicator; and  
means for transmitting said message to said user based on said determining means.

24. (Canceled).

25. (Canceled).

26. (Canceled).

27. The system of claim 23, wherein said activation request, further includes contact information and wherein said system further comprises:  
means for storing said contact information; and  
means for retrieving said contact information in response to a determination by said determining means to transmit said message, wherein said transmitting means transmits said message based on said contact information.

28. The system of claim 23, further comprising a means for communicating said travel data via a control channel associated with a cellular network.

29. The system of claim 28, wherein said communicating means includes a means for changing an identifier associated with said communicating means.

30. The system of claim 28, wherein said communicating means includes a means for appending said travel data to a feature request.

31. A method for automatically activating vehicle status reporting within a vehicle tracking system, comprising the steps of:  
receiving a vehicle indicator and a location indicator from a user at a remote location;  
identifying a vehicle based on said vehicle indicator;  
identifying a proximity based on said location indicator;  
receiving travel data identifying said vehicle and indicating a location of said vehicle;  
monitoring travel of said vehicle based on said travel data;  
determining, based on said monitoring step, whether said vehicle is within said proximity; and  
transmitting a message to said user in response to a determination in said determining step that said vehicle is within said proximity.

32. The method of claim 31, wherein said monitoring step further comprises the step of:  
assuming that said vehicle is traveling along a route at a predetermined rate of travel until said receiving step.

33. (Canceled).

34. (Canceled).

35. The method of claim 31, wherein said receiving a vehicle indicator and a location indicator step includes the step of receiving, from said user, an activation request that includes said vehicle indicator, said location indicator, and contact information, and wherein said transmitting step includes the step of  
transmitting said message based on said contact information.

36. The method of claim 31, further comprising the step of communicating said travel data via a data channel associated with a cellular network.

37. The method of claim 36, further comprising the step of changing an identifier associated with a communications device transmitting said travel data.

38. The method of claim 36, further comprising the step of appending said travel data to a cellular feature request.

39. A method for enabling reporting of impending vehicle arrivals, comprising the steps of:

- receiving a vehicle indicator and a location indicator from a remote user, said vehicle indicator identifying a vehicle and said location indicator indicating a location along a route of travel of said vehicle;

- identifying a proximity based on said location indicator;

- monitoring travel of said vehicle as said vehicle travels along said route; and

- transmitting a message to said user, based on said monitoring step, when said vehicle is within said proximity.

40. (Canceled).

41. The system of claim 1, wherein said activation request includes contact information identifying a user communication device associated with said user, and wherein said communications interface is further configured to transmit said message to said user communications device based on said contact information.

42. The system of claim 1, further comprising:

- a location sensor coupled to said vehicle and configured to determine a location of said sensor, said location sensor further configured to transmit signals based on locations determined by said location sensor; and

- a vehicle manager coupled to said location sensor and configured to wirelessly transmit said travel data, said travel data based on said signals transmitted from said location sensor.

43. The system of claim 13, further comprising:

- a location sensor coupled to said vehicle and configured to determine a location of said sensor, said location sensor further configured to transmit signals based on locations determined by said location sensor; and

- a vehicle manager coupled to said location sensor and configured to wirelessly transmit said travel data, said travel data based on said signals transmitted from said location sensor.

44. The system of claim 43, wherein said vehicle manager is configured to transmit said travel data in response to a determination that said vehicle is off schedule, and wherein said data manager, in tracking said vehicle, is configured to assume that said vehicle is on schedule unless said data manager receives said travel data transmitted from said vehicle.

45. A system for automatically monitoring and reporting upon travel status of vehicles in response to an activation request by users at remote locations, comprising:

a data manager configured to receive a vehicle indicator and a location indicator, to automatically correlate said vehicle indicator with a vehicle and said location indicator with a location along a route of travel of said vehicle, and to transmit a message in response to a determination that said vehicle is within a predetermined proximity of said location; and

a communications interface configured to receive said vehicle indicator and said location indicator from a user at a remote location, to transmit said vehicle indicator and said location indicator to said data manager, and to receive said message from said data manager and to transmit said message to said user.

46. The system of claim 45, wherein said vehicle indicator and said location indicator are included in an activation request that also includes contact information identifying a remote communication device associated with said user, wherein said communications interface is further configured to transmit said message based on said contact information.

47. The system of claim 45, further comprising:

a location sensor coupled to said vehicle and configured to determine a location of said sensor, said location sensor further configured to transmit signals based on locations determined by said location sensor; and

a vehicle manager coupled to said location sensor and configured to wirelessly transmit travel data to said data manager, said travel data based on said signals transmitted from said location sensor.

48. The system of claim 47, wherein said vehicle manager is configured to transmit said travel data to said data manager in response to a determination that said vehicle is off schedule, and wherein said data manager is configured to assume that said vehicle is on schedule unless said data manager receives said travel data.

49. A system, comprising:

a data manager configured to receive a vehicle indicator and a location indicator, to retrieve location data based on said location indicator, to correlate said location data with travel data based on said vehicle indicator, to compare said location data to said travel data, and to transmit a message in response to a determination that said vehicle is a predetermined proximity from a first location along a route of travel of said vehicle, said location data indicating said first location and said travel data indicating a second location of said vehicle along said route of travel; and

a communications interface configured to receive said vehicle indicator and said location indicator from a user at a remote location, to transmit said vehicle indicator and said location indicator to said data manager, to receive said message from said data manager, and to transmit said message to said user.

50. The system of claim 49, wherein said vehicle indicator and said location indicator are included in an activation request that also includes contact information identifying a remote communication device associated with said user, wherein said communications interface is further configured to transmit said message based on said contact information.

51. The system of claim 49, further comprising:  
a location sensor coupled to said vehicle and configured to determine a location of said sensor, said location sensor further configured to transmit signals based on locations determined by said location sensor; and  
a vehicle manager coupled to said location sensor and configured to wirelessly transmit travel data to said data manager, said travel data based on said signals transmitted from said location sensor.

52. The system of claim 51, wherein said vehicle manager is configured to transmit said travel data to said data manager in response to a determination that said vehicle is off schedule, and wherein said data manager is configured to assume that said vehicle is on schedule unless said data manager receives said travel data.

53. A method for automatically activating a vehicle tracking system, comprising the steps of:  
receiving a vehicle indicator and a location indicator from a user at a remote location;  
identifying a vehicle based on said vehicle indicator;  
monitoring travel of said vehicle;  
retrieving location data based on said location indicator;  
comparing said location data to travel data associated with said vehicle;  
determining whether said vehicle is within a predetermined proximity of a location defined in data by said location data; and  
transmitting a message to said user in response to a determination in said determining step that said vehicle is within said predetermined proximity of said location.

54. The method of claim 53, wherein said monitoring step further comprises the steps of:  
receiving a notification message from said vehicle;  
assuming that said vehicle is traveling along a predetermined route at a predetermined rate of travel until said receiving step; and  
determining a location of said vehicle based on said assuming step.

55. The method of claim 53, wherein said receiving a vehicle indicator and a location indicator step includes the step of receiving, from said user, an activation request that includes said vehicle indicator, said location indicator, and contact information, and wherein said transmitting step includes the step of transmitting said message based on said contact information.